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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MAHAFKEY, KELLY J

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/524,014	Applicant(s) ROMEO, AURELIO	
	Examiner Kelly Mahafkey	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Amendments made 7/13/06 have been entered.

The Substitute Specification sent 7/13/06 has been entered.

Claims 1-23 have been canceled.

Claims 24-44 are pending.

Examiner Note: The affidavit filed July 13, 2006 was not filed in English and thus will not be considered in this response.

Prior Specification/Drawing Objections

The previous objections regarding the Specification and the Drawings have been withdrawn in light of applicant's amendments.

Prior Claim Objections/Claim Rejections - 35 USC § 112

The previous rejections and objections regarding the claims have been withdrawn in light of applicant's amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 35 and 36 recites the limitation "starting

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tomato composition" in claims 33 and 34. There is insufficient antecedent basis for this limitation in the claim.

Claims 35 and 36 are further unclear because they recite that cheese can be included in the tomato composition up to 300%. It is unclear how a composition can include 300% of an ingredient.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 24-30, 33, 34, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Glasser et al. (US 4140809).

Glasser teaches of a soup concentrate derived from vegetable matter, including tomatoes (i.e. Glasser teaches of a tomato composition). Glasser teaches that the tomato composition is obtained from tomato juice. Refer specifically to Abstract and Example 2. Glasser teaches that the soup concentrate is mixed with approximately 3-10 parts water (Column 3 lines 9-22) to form a final composition. Glasser teaches that the concentrate composition contains 20-40% soluble solids based on the soup concentrate (Claim 1). Glasser teaches that the soup concentrate has a moisture content of 40-60% (Column 4 lines 9-23). Glasser teaches that the tomato composition, when in final form (i.e. the tomato concentrate when mixed with water) has a moisture content of 85-96%, and thus a solids/dry residue content of 4-15%. Glasser teaches that the tomato composition contains 33.3-100% soluble solids and 0-66.6% insoluble

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solids based on the weight of the total solid/dry residue content. Regarding the dry residue, moisture, insoluble solids, and soluble solids content, refer specifically to the calculations below.

The percentage of solid/dry matter and moisture in the final tomato composition

As stated above, Glasser teaches that the soup concentrate has a moisture content of 40-60% and is mixed with 3 to 10 parts water.

The following depicts the percentage of solid/dry residue in the final composition when 1 part of soup concentrate (40% moisture content) is mixed with 3 parts water:

- i. 3 parts or 75% water
- ii. 1 part or 25% Soup Concentrate (40% moisture content)
 - (1) 40% of the concentrate is water
 - (a) $25\% * 0.40 = 10\%$ water is in the final composition
 - (2) 60% of the concentrate is dry residue
 - (b) $25\% * 0.60 = 15\%$ dry residue is in the final composition

Thus, the final composition, as taught by Glasser, would have a total of 85% water (75% water + 10% water) and 15% dry residue.

The following depicts the percentage of solid/dry residue in the final composition when 1 part of soup concentrate (60% moisture content) is mixed with 10 parts water:

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- iii. 10 parts or 91% water
- iv. 1 part or 9% Soup Concentrate (60% moisture content)
 - (3) 60% of the concentrate is water
 - (c) $9\% \times 0.60 = 5.4\%$ water is in the final composition
 - (4) 40% of the concentrate is dry residue
 - (d) $9\% \times 0.40 = 3.6\%$ dry residue is in the final composition

Thus, the final composition, as taught by Glasser, would have a total of 95.4% water (91% water + 5.4% water) and 3.6% dry residue.

The percentage of insoluble and soluble solids in the final tomato composition

As stated above, Glasser teaches that the soup concentrate has 20-40% soluble solids based on the weight of the soup concentrate. In Column 6 lines 34-36, Glasser teaches that the soup concentrate is to be mixed with water and served (i.e. there are no additional ingredients added to the soup composition). As stated in the calculations above, the soup concentrate has 40-60% dry matter/solid residue.

The following depicts the percentage of insoluble and soluble solids *based upon the total dry residue* in the soup concentrate.

- v. 33.3-100% soluble solids *based upon the total dry residue* in the soup concentrate
 - (5) The concentrate contains 40-60% dry residue
 - (6) The concentrate contains 20-40% soluble solids

(e) Thus, the percentage of soluble solids based on the percentage of dry residue is 33.3% (20/60)- 100% (40/40).

(f) The remaining solids must be insoluble solids. Thus, the percentage of insoluble solids in the soup concentrate based on the percentage of dry residue is 0% (100%-100%)- 66.6% (100%-33.3%).

Since there are no additional solids added when the soup concentrate is made into a final composition, the distribution of insoluble/soluble solids, based upon the number of solids would remain constant. Thus, Glasser teaches of a concentrate that is diluted to form a final composition which includes 85-96% moisture based on the final composition, 4-15% dry residue based on the final composition, 33.3-100% soluble solids based on the dry residue in the final composition, and 0-66.6% insoluble solids based on the dry residue in the final composition.

Glasser teaches that one would modify the amount of soluble and insoluble solids depending on the desired freezing properties of the soup concentrate (Abstract, Column 1 lines 19-52, Column 2 lines 53-68, and Column 3 lines 1-12). Glasser teaches of the vegetable composition in admixture with animal and vegetable fats which are solid or liquid at room temperature (Examples 1-3).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809).

As discussed above, Glasser teaches of a soup concentrate, which is formed into a tomato composition when mixed with water to form a soup. Glasser teaches that the meat and/or preservatives, such as salt can be added to (i.e. sauced by) the tomato composition (Abstract). Glasser, does not explicitly teach the soup concentrate or soup composition as a ready to use sauce for food as recited in claims 39 and 40 or a food comprising the tomato composition as recited in claims 43 and 44.

Regarding the soup concentrate or soup composition as a ready to use sauce for food as recited in claims 39 and 40, it was known at the time the invention was made that soup concentrates and soup compositions were utilized as base mixtures for creating meals such as casserole dishes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the tomato composition in a specific manner depending on the meal to be prepared. One would have been motivated to use the tomato composition as a ready to use sauce in the preparation of a casserole dish.

Regarding a food comprising the tomato composition as recited in claims 43 and 44, at the time the invention was made, it was known to serve soups in both traditional bowls (i.e. non-edible) as well as through edible means, such as bread bowls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the tomato soup composition into a food depending on the desired serving means for the composition. One would have been motivated to use edible

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serving means, such as a bread bowl in order to reduce the amount of dishes to be washed after the meal was finished.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809) as evidenced by Benefits ("The Benefits of Olive Oil").

As discussed above, Glasser teaches of a soup concentrate, which is formed into a tomato composition when mixed with water to form a soup. Glasser teaches that the tomato composition includes fats and/or oils, however is silent to the oil in the tomato composition as olive oil. As evidenced by Benefits, it was known at the time the invention was made that Olive oil provided health benefits when consumed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute one art recognized *functional equivalent* (i.e. olive oil) for another (i.e. cottonseed oil) in the tomato composition as disclosed by Glasser, depending on which oil were more available at the time the invention was made. It would have further obvious to one of ordinary skill in the art at the time the invention was made to include olive oil in the tomato composition as taught by Glasser, in order to gain the known health benefits of olive oil.

Claims 32, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glasser (US 4140809), in view of Terrytx (Creamy Tomato Cheese Soup, 1999 Recipelink.com).

As discussed above, Glasser teaches of a soup concentrate, which is formed into a tomato composition when mixed with water to form a soup. Glasser, however, is silent to the tomato composition as including cheese and 10% fats and/or oils.

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Regarding the tomato composition as including cheese, Glasser teaches that additional ingredients can be added into the tomato composition depending on the desired flavor and texture of the final product (Column 4 lines 3-8 and Column 6 lines 37-42). Terrytx teaches of a soup composition that includes low fat soft cheese. Terrytx teaches that the soup, which includes cheese, is a good soup. Thus, it was known at the time the invention was made to include soft cheeses in soups. It would have been obvious to include a soft cheese in the soup as taught by Glasser depending on the desired final flavor of the soup (i.e. tomato or tomato and cheese, ect). One would have been motivated to use a specific amount of cheese depending on the desired intensity of the cheese flavor in the final product.

Regarding the amount of fats/oils in the tomato composition, Glasser teaches in example 2 that 7.95 oil is included in the tomato composition. Glasser also teaches, Column 4 lines 3-8, that ingredients, such as oils, can be added as desired to provide flavor and texture appeal.

Response to Arguments

Applicant's arguments filed July 13, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an exclusive tomato product) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

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not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues that the reference includes other vegetables and thus is not a tomato composition. It is noted that a tomato composition is a composition, which contains tomatoes. The recitation of "tomato composition" does not limit the composition from including other ingredients.

In response to applicant's arguments that Glasser does not teach of the correct amount of insoluble and soluble matter in the tomato composition as claimed, applicant is referred to the rejection above in which calculations are provided to illustrate that the reference reads upon the claimed amount of insoluble and soluble matter in the tomato composition. It is noted that Glasser's recitation of "insoluble matter" was not used to for the calculations since it does not reflect the amount of "insoluble solids" in the composition.

Applicant argues that the reference does not mention the term "dry residue", however, it was known at the time the invention was made that "dry residue" and the term "solids" are synonymous.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Mahafkey
Examiner
Art Unit 1761



KEITH HENDRICKS
PRIMARY EXAMINER